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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,402	12/28/2001	Hitoshi Matsumoto	VX012397 PCT	3876

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POSZ LAW GROUP, PLC  
12040 SOUTH LAKES DR.  
SUITE 101  
RESTON, VA 20191

EXAMINER

JAGOE, DONNA A

ART UNIT PAPER NUMBER

1614

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/019,402	<b>Applicant(s)</b> MATSUMOTO ET AL.	
	<b>Examiner</b> Donna Jagoe	<b>Art Unit</b> 1614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-30,32-40 and 42-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-30,32-40 and 42-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Claims 27, 28, 30, 33, 35-38 and 40 have been amended and claim 41 has been canceled. New claims 42-49 have been added.

***Claims 27-30, 32-40 and 42-49 are pending in this application.***

***Response to Amendment***

Objection of claims 37 and 38 and is **withdrawn** in view of the amendment.

Rejection of claims 35, 36, 38 and 40 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is **withdrawn** in view of the amendments.

Rejection of Claims 35-40, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is **withdrawn**.

***New Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27-30 and 32-40 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention." (MPEP 2173).

The term "and monosaccharide is not essentially found" in claims 27 and 45 is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and thus one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Because the term "and monosaccharide is not essentially found" has not been defined in a clear, objective manner, such would require subjective interpretations of whether or not a monosaccharide is found by use of the term "not essentially found". The term "not essentially found" does not exclude monosaccharide. Additionally, the claim language *comprising* leaves the claim open for the inclusion of unspecified ingredients, even in major amounts, including the monosaccharide. It is therefore the Examiner's position that the public would not be informed of the boundaries of what constitutes infringement of the present claims and thus the claims fail to meet either the tenor or express requirements of 35 U.S.C. § 112, second paragraph and are properly rejected.

The remaining claims are indefinite to the extent that they read on the rejected base claims.

***Art Rejections of Record***

Claims 27-29, 35-40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lawhon et al. U.S. 4,643,902 (A) in view of Nakhmedov et al. (Konservnaya I Ovoshchesushil'naya Promyshlennost (U) and Laboratoires Chibret, GB 1,007,751 (N).

Lawhon et al. teach purifying and concentrating juice such as currant juice through by reverse osmosis and optionally by ion exchange resin. It does not teach black currants. It would have been obvious to substitute black currant juice instead of currant juice since Lawhon et al. teach the reverse osmosis and ion-exchange to be employed for currant juice. It is prima facie obvious to substitute equivalents motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. *In re Ruff* 118 USPQ 343; *In re Jezet* 158 USPQ 99; the express suggestion to substitute one equivalent for another need not be present to render the substitution obvious. *In re Font*, 213 USPQ 532. Since the process is applicable to currants one of ordinary skill in the art would have been motivated to employ the method of extracting the juice from black currants by reverse osmosis and/or ion-exchange resin since Lawhon et al. teach it to be useful to produce juice from currants.

Lawhon et al. does not teach the percent solids in the black currant material for food. Nakhmedov et al. teach that wastes from black currant contained 5 to 10% solids, which is encompassed by the instantly claimed 5 to 25%. Regarding the delphinidin-3-

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o-rutinoside, it is known that delphinidin 3-rutinoside is contained in the anthocyanin of black currant fruit as recited by Nakhmedov et al. (see abstract).

Regarding claims 37 and 38, drawn to the composition for improving visual function, of alleviating asthenopia and/or improving adaptation to darkness, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

“The patentability of a product does not depend upon its method of production. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, then the claim is unpatentable even though the prior art product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

Laboratoires Chibret teach that anthocyanin glucosides such as those obtained from bilberries are useful for visual acuity enhancing night vision (column 1, lines 20-25). It would have been obvious to employ black currant anthocyanin for vision problems such as visual acuity and night vision. Motivation to employ black currants

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would come from the knowledge that Laboratoires Chibret teach anthocyanins such as those obtained from bilberries to be useful for such a purpose. It is prima facie obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. *In re Ruff* 118 USPQ 343; *In re Jezei* 158 USPQ 99; the express suggestion to substitute one equivalent for another need not be present to render the substitution obvious. *In re Font*, 213 USPQ 532. Since both bilberries and black currants contain anthocyanin, it would have been obvious to employ black currants to improve vision since Laboratoires Chibret teach anthocyanin containing vegetable extracts of fruit juices to be useful for such a purpose.

### ***Response to Arguments***

Applicant's arguments filed March 9, 2006 have been fully considered but they are not persuasive. The rejections made in the paper mailed September 9, 2005 of claims 27-29, 35-40, and extending to new claims 42-49, rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lawhon et al. U.S. 4,643,902 (A) in view of Nakhmedov et al. (Konservnaya I Ovoshchesushil'naya Promyshlennost (U) and Laboratoires Chibret, GB 1,007,751 (N) are **maintained** and hereby repeated for the reasons set forth in the previous office action and those set forth below.

Applicant's arguments, see pages 13-15, filed March 9, 2006, with respect to claims 30 and 32-34 have been fully considered and are persuasive. The rejection of

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claims 30 and 32-34 over Lawhon et al. US. Patent No. 4,643,902 has been **withdrawn**.

Applicant has amended claims to recite that the monosaccharide is not essentially found (claims 27, 45 and 48) and an organic acid content of not more than 5 % by weight on the basis of solid matters (claims 27, 42 and 46). Applicant asserts that Nakhmedov cannot disclose or suggest the inventions defined in claims 27, 42, 45, 46 and 48 because of the significant content of organic acid and sugars that are contained in e.g. table 3. In response, regarding the sugar content of Nakhmedov, applicant is directed to the above 112 2<sup>nd</sup> rejection regarding the sugar content. Additionally, the claim language *comprising* leaves the claim open for the inclusion of unspecified ingredients, even in major amounts, such as the sugar. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Lawhon et al. teaches that an ion exchange column is used to reduce the acid content so that the Brix reading to the grams of acid, is not less than 21 to 1 or more than 26 to 1. Applicant also contends that Table 1 of Nakhmedov is referring to marcs, the residue remaining after a fruit has been pressed, and not the solution of black currant juice, such as required in new claim 46. It would have been obvious to one of ordinary skill in the art to employ anthocyanin in a fruit juice as claimed in claim 46 by suspending the anthocyanin in water to attain a concentrated solution. Regarding the delphinidin-3-o-



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rutinoside, it is not new to claim that delphinidin-3-o-rutinoside is contained in anthocyanin. Delphinidin-3-o-rutinoside is a well-known component of anthocyanin and is recited on page 7 of Nakhmedov in that spots of delphinidine and delphinidine-3-rutinoside were more intense (see page 7).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the negativity charged reverse osmosis membrane of applicant's claims fractionates compounds depending on a charge of polymer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding new claims 42-49, the claims are rejected on the same grounds as the current grounds of rejection for the reasons indicated in the stated grounds of rejection. The anthocyanin compositions of claims 42-49 appear to be the same. Regarding claims 44 and 45, **"The patentability of a product does not depend upon its method of production.** If the product in a product-by-process claim is the same as or obvious from a product of the prior art, then the claim is unpatentable even though the prior art product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the applicant to come forward with evidence establishing an unobvious difference between the claimed product and the

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prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983). In the absence of unexpected results, the prior art black currant anthocyanin containing composition appears to be the same.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna Jagoe whose telephone number is (571) 272-0576. The examiner can normally be reached on Monday through Thursday from 9:00 A.M. - 3:00 P.M..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Donna Jagoe  
Patent Examiner  
Art Unit 1614

May 24, 2006

  
**ARDIN H. MARSCHEL**  
**SUPERVISORY PATENT EXAMINER**